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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,765	12/18/2000	Martti Talja	2880/323	1794
26646	7590	10/29/2004		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER ISABELLA, DAVID J	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/737,765	TALJA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID J ISABELLA	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4 and 5 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 6-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

***Status of the Claims***

Claims 1,2,4-13 are pending. Claims 6-13 are newly added claims and claims 1,2,4 and 5 have been amended.

***Election/Restrictions***

Amended claims 1,2,4,5 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claim are no longer directed to a internally reinforced biodegradable material put is directed to uniaxially or biaxially oriented polymer. Newly added claims 6-13 are directed to the scope of the elected invention and will therefor be examined. Contrary to applicant's arguments, the original claims were directed to a surgical implant comprising: a biodegradable material internally reinforced in a longitudinal direction having a helical configuration. This embodiment is clearly distinguishable from a biodegradable material comprising oriented or aligned structural units included in the micro-structure or molecular structure of a material such as oriented parts of molecules. The former being a material that is reinforced whereas the later is a material wherein the polymer structure of the material contains aligned molecular structure.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1,2,4,5 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silvestrini, et al (4610688) in view of either of Vert, et al (4279249) or Tormala et al (4743257).

Silvestrini, et al discloses a helically braided fabric prosthesis wherein the fibers may be resorbable. Silvestrini, et al does not disclose fibers having a resorbable matrix with a resorbable reinforcing element. Each of Vert, et al and Tormala et al teach the use of a composite polymer material where the composite comprises a resorbable matrix with a resorbable reinforcing element. Silvestrini et al requires fibers of high strength and modulus. The material of Tormala et al is a self reinforced composite whereas Vert et al is a reinforced composite. Both materials possess good strength and modulus and may be used to provide fibers of high strength and modulus in the fabric of Silvestrini, et al. It would have been obvious to one with ordinary skill in the art to use the resorbable composite material of either of Vert et al or Tormala et al as the resorbable component of Silvestrini et al since high strength and modulus is desired.

Claims 7-9 see column 3, lines 15+ of Silvestrini et al.

Claim 10, the helical winding of Silvestrini et al resemble a screw-thread configurations.

Claim 11, see column 5, lines 10+ of Silvestrini et al.

Claims 12 and 13, see abstract of Tormala et al.

### ***Response to Arguments***

Applicant's arguments filed 6/1/2004 have been fully considered but they are not persuasive. Applicant's arguments that there is no motivation or suggestion either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the teachings of the references to produce the surgical implant as recited in claim 6 is not persuasive. Each of Vert, et al and Tormala et al teach the use of a composite polymer material where the composite comprises a resorbable matrix with a resorbable reinforcing element. Silvestrini et al requires fibers of high strength and modulus. The material of Tormala et al is a self reinforced composite whereas Vert et al is a reinforced composite. Both materials possess good strength and modulus and may be used to provide fibers of high strength and modulus. Silvestrini recognizes the importance of physical properties of the sub-elements comprising the overall combination of the prosthetic device. The choice in utilizing a starting product, including a fiber with particular properties including strength and modulus in the manufacturing the fabric of Silvestrini, et al would have been obvious to one with ordinary skill in any art, including the medical art. Selection of a fiber produced by the methods of Vert, et al and Tormala et al would have been obvious to one with ordinary skill as an equivalent

resorbable composite material depending on the desired properties including strength and modulus. There is nothing in Silvestrini, et al that teaches away from using resorbable fibers made according to the methods of Vert,et al and Tormala, et al. Clearly one with ordinary skill in the art could create fibers of a first set exhibiting greater elasticity, than the fibers of both of the second and third sets, and formulating the fibers of the second and third sets to have greater yield strength and Young's modulus than the fibers of the first set.

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PATENT: 5810882 BOLDUC

US PATENT: 5810857 YOON

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
October 26, 2004